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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,219

Applicant(s)

PERLMUTTER, THOMAS

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 22-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 30-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-21, 30-40, drawn to methods and systems for sending and displaying an ad on a client system, classified in class 705, subclass 14.
 - II. Claims 22-29, drawn to methods for billing advertisers for displayed ads, classified in class 705, subclass 14.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as for billing advertisers for ads shown without ad playing scripts and ad/content layers. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Roger Wise on 5/1/03 a provisional election was made without traverse to prosecute the invention of group I, claims 1-21, 30-40. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 22-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

1. Applicant is advised that should claim 11 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 14-17 should apparently depend from claim 13.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. **Claims 1, 2, 5, 6, 8-11, 18, 19, 21, 30, 33, 34, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Gever et al (US6329994).** Gever et al teaches methods and systems for sending animations over a network to a user (client with browser).

Regarding claims 1, 2, 5, 8, 9, 18, The animations are provided as advertising and they are layered on top of other main browser content [fig 6B, col 21 lines 60-65, col 22 lines 5-8, col 28 lines 35-38]. The smart object animation is controlled by a transmitted script played by the client [col 28 line 65 to col 29 line 5]. Col 30-31 describes creation of a message content and script, both sent to a client over the Internet and activated via a browser visiting a URL. The animation is controlled by trigger events as defined by the animation script.

Regarding claims 6, 11, 19, 34, the animation is defined with trigger events [col 30 lines 57-59].

Regarding claim 10, 21, 36, the animated layer(s) obscure (prevent access to) the main content beneath, yet enable other areas to operate (be accessed) [col 21 line 63-col 22 line 8].

Regarding claims 30, 33, the verifying code step before ad is played can be taken to be merely the act of ensuring the required files are downloaded/available and non-corrupted, which is inherently performed by the methods of Gever et al. The identification code may be taken to be the required urls/filenames that are executed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 7, 12, 17, 20, 35, 37, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al.**

Regarding claims 7, 12, 17, 20, 35, 37, 40, Gever et al does not appear to describe removal of the animation, yet it would have been obvious to one of ordinary skill at the time of the invention to have removed the animation when the animation is complete, so that the user can then access the underlying main content otherwise inaccessible during the advertising animation.

Regarding claim 39, this is rejected as per claim 21 above.

6. **Claims 3, 4, 13-16, 30 (alternatively), 31, 32, 33-36 (alternatively) and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al in view of Alberts (US5937392).**

Regarding claims 3, 13, Alberts teaches features of Internet advertising including sending content from a web server and ads from an ad server. It would have been obvious to one of ordinary skill at the time of the invention to have used known techniques to have delivered the required files for Gever et al's content and animation from different servers as taught by Alberts.

Regarding claim 4, it would have been obvious to one of ordinary skill at the time of the invention for a creative entity to have generated/designed the animated advertising content and sent it to the content provider so that it can be transmitted to the user's browser; this would enable the creative animation to be contracted out.

Regarding claims 14-16, 34, 36, these features are met as explained above.

Regarding claims 30-33, Alberts teaches providing unique Ids and other codes to ads. These codes identify the certain ads and enable rotation control in terms of how often to play, when to stop dates (expiration), triggering circumstances, etc [col 3 lines 25-col 4 line 25]. It would have been obvious to one of ordinary skill at the time of the invention to have implemented such coding with the ads of Alberts so that rotation control and ad display tracking can be used. Registration code can be taken to be an ad which is registered to be shown a certain number of times per day.

Regarding claim 35, this is rejected as per claim 7 above.

Regarding claim 38, Alberts teaches tracking what ads have been displayed and how often [col 4 lines 4-7].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
May 2, 2003